



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,722	03/27/2001	Eric Flam	FLAM 2A	1331

7590 06/15/2005
Henry I. Schanzer, Esq.
29 Brookfall Road
Edison, NJ 08817

EXAMINER

BROWN, MICHAEL A

ART UNIT	PAPER NUMBER
----------	--------------

3764

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,722

Applicant(s)

FLAM ET AL.

Examiner

Michael Brown

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11-36, 38-77 and 79-90 is/are pending in the application.
- 4a) Of the above claim(s) 41-66 and 83-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 21-22 is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-20, 23-36, 38-40, 67-77, 79-82 and 87-90 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 13-20, 23, 28, 40, 67-72, 75-77, 79-82 and 87-90 are rejected under 35 U.S.C. 102(b) as being anticipated by Engelman.

Engelman discloses in figures 5-6 a leg elevator that anticipates a prosthesis comprising a protective device (or referred to as a protective structure) 17, a hard outer shell 10. The pad is made of a soft material (foam), the pad is made in a semicircular shape and a means S1-S3 for securing. The pad extends beneath the foot and heel (fig. 6). The protective structure is shaped to be placed between a body part and a supporting surface. The (pad) protective device is fabricated of a firmness. The pad is fabricated of a material that enables tissue growth (foam) and dissolves over time.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Mercer.

Art Unit: 3764

Mercer discloses in figures 1-5 a cast that anticipates a prosthesis comprising a protective device 18, a rigid outer shell 14 and a rigid inner shell 16.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 11-12, 24-30 33-36 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelman.

Engelman discloses in figures 5-6 a prosthesis, device, substantially as claimed. However, Engelman doesn't disclose the pad having a thickness of one fourth of an inch, a length one quarter of an inch and a width one quarter of an inch. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the thickness of the pad disclosed by Engelman could be one fourth of an inch and the width and the length could be one quarter of an inch because the dimension is not critical and it doesn't provide novelty over the prior art. The width and length of the pad being between one quarter and six inches is a design choice.

Claims 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelman.

Engelman discloses in figures 5-6 a leg elevator that anticipates a prosthesis, substantially as claimed. However, Engelman does not disclose the protective device being a rectangular shaped. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the protective device disclosed by Engelman could be rectangular shape because it is a design choice as to how the protective device is shaped. The protective device could also be oblong in shape.

Claims 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelman in view of Swartz.

Engelman discloses in figures 5-6 a leg elevator, that anticipates a prosthesis, substantially as claimed. However, Engelman does not disclose a layer between the user's skin and the outer surface of the pad. Swartz teaches in figure 2 a protective device comprising a layer 14 that is located between a layer 16 and the outer skin of the user's foot. It would have been obvious to one having ordinary skill in the art at the time that the invention was made, that the layer that is between the user's skin and the lower layer as taught by Swartz could be incorporated into Engelman in order to have a layer that is breathable to allow air to pass through the layer.

Claims 73-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelman in view of Suzuki.

Engelman discloses in figures 5-6 a leg elevator, that anticipates a prosthesis, substantially as claimed. However, Engelman does not disclose the pad including a fatty substance. Suzuki teaches in figure 1 a protective device comprising a fatty substance that includes a fatty substance that includes silicone (col. 6, lines 29-31). It

Art Unit: 3764

would have been obvious to one having ordinary skill in the art at the time that the invention was made that the fatty substance including the silicone as taught by Suzuki could be incorporated into the device disclosed by Engleman in order to use the silicone to prevent fluids from being absorbed into the protection device.

Allowable Subject Matter

Claims 21-22 are allowed.

Conclusion

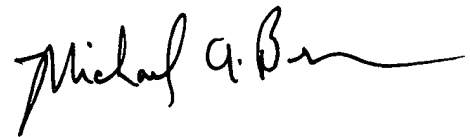
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. No additional prior art was cited in the first office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brown whose telephone number is 703-308-2682. The examiner can normally be reached on 5:30 am-4:00 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Brown
May 31, 2005

A handwritten signature in black ink, appearing to read "Michael A. Brown", with a long horizontal flourish extending to the right.

MICHAEL A. BROWN
PRIMARY EXAMINER